



RECEIVED

DEC 23 2003

TC 1700

AF\$
/CC

Docket No.: F-7905

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

MAIL STOP: APPEAL BRIEF-PATENTS

By: Loren D. Pearson

Date: December 9, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Applic. No. : 10/036,178 Confirmation No.: 4849
Inventor : Derrick J. Dimone
Filed : November 9, 2001
TC/A.U. : 1775
Examiner : Gwendolyn A. Blackwell Rudasil
Docket No. : F-7905
Customer No. : 24131

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

BRIEF ON APPEAL

S i r :

This is an appeal from the final rejection in the Office action dated June 4, 2003, finally rejecting claims 1-5 and 7-14.

Appellants submit this *Brief on Appeal* in triplicate, including payment in the amount of \$165.00 to cover the fee for filing the *Brief on Appeal* for a small entity.

12/17/2003 MDANTE1 00000109 10036178

01 FC:2402

165.00 OP

Real Party in Interest:

This application is assigned to Derrick J. Dimone, Robert J. Lapolla, and Deborah Radbell. The assignment was recorded under Reel No. 011274 and Frame No. 0905 on November 9, 2000.

Related Appeals and Interferences:

No related appeals or interference proceedings are currently pending that would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims:

Claims 1-5 and 7-14 are rejected and are under appeal.

Status of Amendments:

No claims were amended after the final Office action. A Notice of Appeal was filed on October 9, 2003.

Summary of the Invention:

As stated in the first paragraph on page 1 of the specification of the instant application, the invention relates to color inserts that decorate automobile insignia. In particular, the invention relates to resin containing inserts that decorate an automobile insignia by attaching to the automobile.

Appellant explained on page 9, line 13, that, referring now to the figures of the drawing in detail and first, particularly, to Fig. 1 thereof, there is seen a color insert 1. The color insert 1 has a colored layer 3. Typically, the colored layer 3 is opaque. The colored layer 3 can also be reflective. The colored layer 3 can be colored to compliment the color of the automobile being decorated. The colored layer 3 can also be colored to form a design. The colored layer 3 has a outside facing away from the automobile and inside facing the automobile. Preferably, at least the outside is colored. The colored layer 3 is preferably a polyester film such as that sold under the trademarks MYLAR® and KODAK®. The colored layer 3 can also be made with Vinyl or other similar resins, foils, and papers.

Appellants further explained on page 9 of the specification, line 16, that a lens 2 overlays the outside of the colored layer 3. The lens 2 is a transparent resin. Preferably, the lens 2 is made from a material having a high refractive index; i.e. greater than the refractive index of air. Such a material produces a magnifying-glass effect over the colored layer 3. The lens 2 can have a thickness that makes it flush with an automobile insignia in which it is inserted.

Appellants outlined on page 10 of the specification, line 5, that Fig. 2 shows an embodiment similar to that in Fig. 1 with the addition of an adhesive layer 4. The adhesive layer 4 attaches to the inside of the colored layer 3. The adhesive layer 4 attaches the color insert 1 to the automobile. Preferably, the adhesive layer 4 is double-sided tape. Other adhesives such as glue are also possible. The adhesive layer 4 can be a type that allows the colored insert 1 to attach releasably to the automobile.

It is further stated on page 10 of the specification, line 9, that Fig. 3 depicts a further embodiment similar to Fig. 2 in which a magnet 5 is added to the inside of the adhesive layer 4. The magnet 5 allows the color insert to attach releasably to the automobile. Preferably, the magnet is rubberized to prevent scratches to the automobile's finish.

Appellants stated in the last paragraph on page 10 of the specification, line 14, that Fig. 4 shows an automobile insignia 6. The insignia 6 is a chrome insignia attached to the body of the automobile. The insignia 6 defines spaces 7 through which the underlying automobile is exposed. The colored inserts 1 are cut to match the spaces 7 and therefore complement the insignia 6. The colored inserts are then

inserted into the spaces 7. The colored inserts 1 can be held on the automobile by magnet 5 or adhesive layer 4.

Appellants outlined on page 11 of the specification, line 1, that the different pieces of colored inserts 1 can have different colors to form different designs.

It is stated in the last paragraph on page 11 of the specification, line 4, that the colored inserts 1 are removable to allow easy customization and interchanging of pieces.

References Cited:

U.S. Patent No. 4,801,479 (Fielder et al.), dated January 31, 1989.

U.S. Patent No. 5,549,940 (Noone), dated August 27, 1996.

Issue:

Whether or not claims 1-5 and 7-14 are unpatentable over Fielder et al. (U.S. 4,801,479) in view of Noone (U.S. 5,549,940) under 35 U.S.C. §103(a).

Grouping of Claims:

Claim 1 is independent. Claims 2-5 and 7-14 depend on claim 1. Claims 2-5 and 7-14 stand or fall with claim 1.

Arguments:

In item 3 of the June 4, 2003, Final Rejection, the Examiner rejected claims 1-5 and 7-14 as being unpatentable over Fielder et al. (U.S. 4,801,479) in view of Noone (5,549,940) under 35 U.S.C. § 103(a).

Claim 1 of the instant application calls for, "A filler for decorating an insignia disposed on a surface and having at least one space formed therein and exposing the surface, comprising an insert adapted to fill the space and lie directly on the surface." (Emphasis added by Appellants.)

The invention is a device (i.e. a "filler") for decorating an automobile insignia. Similar to a stained-glass window, the invention fills in the spaces of the insignia on an automobile and allows an owner to customize the appearance of their automobile. In addition, the filler works in conjunction with the existing insignia, which acts as a border or frame, to create an organized, clean, customized look.

The only time that the Examiner discusses the combination of a filler and an insignia is in the final sentence of page 3 of the June 4, 2003, Office action. This sentence merely states the following:

In addition, it would also be within the skill of one in the art to trim the decorative article of Fielder et al. to fit the area where the decoration is desired as evidenced by the Noone reference that further discloses that decorative articles can be trimmed to the desired size to obtain a customized automobile decoration.

Implicit from this sentence is that neither Noone, nor any of the other references, teaches a filler that is shaped to complement and decorate an automobile insignia.

Noone merely teaches to trim one-size-fits all items to the size of a vehicle.

A roll of wide flexible tape 10 is shown ... in a predetermined length (preferably in excess of the circumference around the sides of a standard sports utility vehicle). ... Either [magnetic or adhesive] tape can be trimmed by the consumer to the desired length." (Noone, col. 5, lines 4-16.)

Noone, col. 5, lines 24-26 and 36-38 refers to additional trimming.

Noone never suggests cutting a tape to complement and work with an existing part of the car (i.e. the insignia) to combine to form a customized decoration. Furthermore, neither Noone, nor Fiedler et al., nor the other prior art teach or suggest the type of decoration that can be achieved when the filler according to the invention is combined with an automobile insignia.

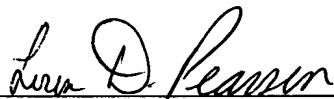
The Examiner's analysis fails to recognize the significance of combining an existing automobile insignia with a filler according to the invention to create a new overall, combined decoration that relies on qualities from the insignia and the filler. In other words, the invention teaches a filler that combines with the insignia framework to form a decoration that is analogous to a stained glass window. While even if the insignia and, in arguendo, the material of the filler may be old, the combination of those has never been taught and is not suggested by the prior art.

Accordingly, the filler to be used with an insignia according to claim 1 is not obvious over Fiedler et al. in light of Noone. In addition, claims 2-5 and 7-14 are ultimately dependent on claim 1 and are patentable for the same reasons.

Applic. No. 10/036,178
Brief on Appeal, filed 12/9/03

The honorable Board is therefore respectfully urged to reverse
the final rejection of the Primary Examiner.

Respectfully submitted,



For Appellants

LOREN DONALD PEARSON
REG. NO. 42,987

LDP/bb

Date: December 9, 2003
Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, Florida 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101



Appendix - Appealed Claims:

1. A filler for decorating an insignia disposed on a surface and having at least one space formed therein and exposing the surface, comprising an insert adapted to fill the space and lie directly on the surface.
2. The filler according to claim 1, wherein said insert includes a colored layer.
3. The filler according to claim 2, wherein said colored layer is a polyester film.
4. The filler according to claim 3, wherein said colored layer is a vinyl.
5. The filler according to claim 2, wherein said colored layer has an outside relative to the surface, and a lens overlays and connects to said outside.
7. The filler according to claim 2, wherein said colored layer has an inside relative to the surface, and a magnet for attracting an automobile underlies and connects to said inside.

8. The filler according to claim 7, wherein said magnet is rubberized.

9. The filler according to claim 7, including an adhesive underlying said magnet for attaching to an automobile.

10. The filler according to claim 9, wherein said adhesive is double-sided tape.

11. The filler according to claim 2, wherein said colored layer has an inside, and an adhesive for attaching to an automobile underlies and connects to said inside.

12. The filler according to claim 11, wherein said adhesive is double-sided tape.

13. The filler according to claim 1, wherein the surface is part of a vehicle.--

14. The filler according to claim 1, wherein:
the insignia is an automobile insignia; and
the surface is part of an automobile.